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EXAMINER	
JARRETT, SCOTT L	
ART UNIT	PAPER NUMBER
3623	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/814,397	APONTE ET AL.	
	Examiner	Art Unit	
	SCOTT L. JARRETT	3623	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 June 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *21 June 2004* is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date *7/28/04, 3/31/03*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

1. This Non-Final Office Action is in response to Applicant's submission filed June 21, 2004. Currently Claims 1-20 are pending.

Abstract

2. The abstract of the disclosure is objected to because applicant recites the acronym RFP. Examiner requests applicant replace RFP with Request For Proposal to overcome this objection. Correction is required. See MPEP § 608.01(b).

Claim Objections

3. Claims 1-20 are objected to because of the following informalities.

4. Regarding Claims 1, 7, 11 and 15, claims 1, 7, 11 and 15 recite that "each descriptive item *can be* assigned a raw numerical score" however the method/system does not actually assign a raw numerical score as claimed. For the purposes of examination examiner assumes the applicant will amend the claims to recite that system/method or scorer actually assigns a raw numerical score.

Regarding Claims 8, 12 and 16, claims 8, 12 and 16 recite that "a confidence factor *can be* assigned to each of the plurality of descriptive items" however the system/method does not actually assign a confidence factor to each of the descriptive items. For the purposes of examination examiner assumes applicant will amend the

claims to recite that the system or method actually assigns a confidence factor to the plurality of descriptive items.

Appropriate correction is required.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Regarding Claim 1, Claims 1-6 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, a § 101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876). The process steps in claims (1-6) are not tied to another statutory class nor do they execute a transformation. Thus, they are non-statutory.

Regarding Claims 1 and 15, the claims, as currently recited, appear to be directed to a compilation of data without any tangible result and are therefore deemed to be non-statutory while the compilation of data may have some real world value (i.e.

utility/usefulness) there is no requisite functionality present to satisfy the practical application requirement nor are there any "acts" which transform the data and/or cause a physical transformation to occur outside the computer (i.e. not concrete or tangible) therefore the invention as claimed does not produce a useful, concrete, and tangible result.

Merely claiming nonfunctional descriptive material, i.e., abstract ideas, stored in a computer-readable medium, in a computer, on an electromagnetic carrier signal does not make it statutory. See Diamond v. Diehr, 450 U.S. 175, 185-86, 209 USPQ 1, 7-8 (1981) (noting that the claims for an algorithm in Benson were unpatentable as abstract ideas because "[t]he sole practical application of the algorithm was in connection with the programming of a general purpose computer."). Such a result would exalt form over substance. In re Sarkar, 588 F.2d 1330, 1333, 200 USPQ 132, 137 (CCPA 1978) ("[E]ach invention must be evaluated as claimed; yet semantogenic considerations preclude a determination based solely on words appearing in the claims. In the final analysis under 101, the claimed invention, as a whole, must be evaluated for what it is.") (Abele, 684 F.2d 902, 907, 214 USPQ 682, 687(CCPA 1982)). See also In re Johnson, 589 F.2d 1070, 1077, 200 USPQ 199, 206 (CCPA 1978) ("form of the claim is often an exercise in drafting"). Thus, nonstatutory music is not a computer component and it does not become statutory by merely recording it on a compact disk. Protection for this type of work is provided under copyright law.

A claimed invention is deemed to be statutory, if the claimed invention produces a useful, concrete, and tangible result. An invention, which is eligible for patenting under

35 U.S.C. 101, is in the "useful arts" when it is a machine, manufacture, process or composition of matter, which produces a concrete, tangible, and useful result. The fundamental test for patent eligibility is thus to determine whether the claimed invention produces a "use, concrete and tangible result". See AT&T v. Excel Communications Inc., 172 F.3d at 1358, 50 USPQ2dat 1452 and State Street Bank & Trust Co. v. Signature Financial Group, Inc., 149 F.3d at 1373, 47 USPQ2d at 1601 (Fed. Cir. 1998).

The test for practical application as applied by the examiner involves the determination of the following factors"

(a) "Useful" - The Supreme Court in Diamond v. Diehr requires that the examiner look at the claimed invention as a whole and compare any asserted utility with the claimed invention to determine whether the asserted utility is accomplished. Applying utility case law the examiner will note that:

i. the utility need not be expressly recited in the claims, rather it may be inferred.

ii. if the utility is not asserted in the written description, then it must be well established.

(b) "Tangible"-Applying In re Warmerdam, 33 F.3d 1354, 31 USPQ2d 1754 (Fed. Cir. 1994), the examiner will determine whether there is simply a mathematical construct claimed, such as a disembodied data structure and method of making it. If so, the claim involves no more than a manipulation of an abstract idea and therefore, is nonstatutory under 35 U.S.C. 101. In Warmerdam the abstract idea of a data structure

became capable of producing a useful result when it was fixed in a tangible medium, which enabled its functionality to be realized.

(c) "Concrete" - Another consideration is whether the invention produces a "concrete" result. Usually, this question arises when a result cannot be assured. An appropriate rejection under 35 U.S.C. 101 should be accompanied by a lack of enablement rejection, because the invention cannot operate as intended without undue experimentation.

In the present case, claims 1-3 and 15-20 merely recite a method for comparative evaluation of a plurality of potential suppliers (i.e. useful and concrete). While the invention may be concrete and/or useful, there does not appear to be any tangible result.

Regarding Claims 7-10, claims 7-10 do not utilize the proper computer program product format and effectively recite descriptive material (software) per se and are therefore deemed to be directed to non-statutory subject matter where there is no indication that the proposed software is recorded on computer-readable medium and/or capable of execution by a computer. Examiner suggests that the applicant incorporate into Claims 7-10 language that the proposed software is recorded on computer-readable medium and capable of execution by a computer to overcome this rejection.

Correction required. See MPEP § 2106 [R-2].

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

8. Claims 1, 4, 7, 11, 15 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michlowitz et al., U.S. Patent Publication No. 2002/0072953 in view of Case et al., U.S. Patent No. 5,734,890.

Regarding Claims 1, 4, 7, 11 and 15 Michlowitz et al. teach a method of facilitating comparative analysis of a plurality of potential suppliers comprising (Figures 3, 5, 7-8):

- creating a scorecard comprising a plurality of descriptive items relative to the potential suppliers the descriptive items having weights and can be assigned a raw numerical score by a scorer (Paragraphs 0008, 0032, 0038);

- distributing the scorecard to a plurality of evaluators (reviewers; Paragraphs 0030; Figures 3, 5);

- collecting responses from at least some of the plurality of evaluators comprising the raw numerical score for at least some of the plurality of descriptive items (Paragraphs 0026, 0029-0030; Figure 5);

- consolidating the responses to assign at least some of the plurality of supplier weighted scores based on at least in part on the raw number score and weights for at least some of the suppliers (Paragraphs 0032; Figures 3, 7-8); and

- generating at least one report based on at least in part on the weighted scores (Abstract; Paragraphs 0008, 0034; Figure 10).

Michlowitz et al. does not expressly teach item weights and category weights as claimed.

Case et al. teach creating a scorecard comprising a plurality of descriptive items relative to a plurality of potential suppliers the descriptive items having weights organized into a plurality of categories having category weights (Tables 1-3; Column 3, Lines 24-50; Column 5, Lines 1-18) wherein each descriptive item can be assigned a raw numerical score by a scorer (Column 3, Lines 52-63; Column 5, Lines 18-65; Columns 11-12), collecting responses from a evaluator comprising the numerical score for at least some of the descriptive items and assigning at least some of the plurality of suppliers weighted scores based in part on the raw numerical score, the category weights and the item weights for a least some of the plurality of suppliers (Table 1; Column 5, Lines 1-15; Column 6, Lines 42-51; Column 14, Lines 25-65) in an analogous art of comparative evaluation of a plurality of potential suppliers (vendor/supplier selection, evaluation, assessment) for the purpose of determining the importance of each descriptive item and descriptive item category for relative to a plurality of potential

suppliers a reviewer's (customer, buyer, evaluator's, etc.; Column 3, Lines 63-68) decision criteria.

It would have been obvious to one skilled in the art at the time of the invention that the system and method of facilitating comparative evaluation of a plurality of potential suppliers by a plurality of reviewers as taught by Michlowitz et al. would have benefited from utilizing the category and item weights of Case et al.; the resultant system/method enabling businesses to determine the importance of each descriptive item and descriptive item category for relative to a plurality of potential suppliers a reviewer's decision criteria (Case et al.: Column 3, Lines 63-68).

Regarding Claims 18 Wichlowitz et al. teach a system and method for facilitating comparative evaluation of a plurality of potential suppliers further comprising a network to collect responses (Paragraph 0026; Figures 1, 2).

9. Claims 2-3, 5, 6, 8-10, 12-14 and 16-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Michlowitz et al., U.S. Patent Publication No. 2002/0072953 in view of Case et al., U.S. Patent No. 5,734,890 as applied to claims 1, 7, 11 and 15 above, and further in view of Wakeman et al., U.S. Patent No. 6,353,767.

Regarding Claims 2, 8, 12 and 16 neither Wichlowitz et al. nor Case et al. expressly teach that the responses include a confidence factor as claimed.

Wakeman et al. teach assigning a confidence factor to each of a plurality of descriptive items relative to a plurality of potential suppliers and further teaches producing an average confidence factor for at least some of the plurality of suppliers (Column 1, Lines 57-68; Column 2, Lines 1-5, 35-46; Column 4, Lines 36-58; Figures 2, 4; Table 1) in an analogous art of facilitating evaluation of a plurality of suppliers for the purpose of estimating the strength and/or a range of the item's score/rating (Column 1, Lines 58-68; Column 2, Lines 1-5).

It would have been obvious to one skilled in the art at the time of the invention that the system and method for facilitating comparative evaluation of a plurality of potential suppliers as taught by the combination of Wichlowitz et al. and Case et al. would have benefited from assigning a confidence factor to a plurality of descriptive items as well as generating an average confidence factor in view of the teachings of Wakeman et al.; the resultant system/method enabling businesses (users) to estimate a

range of a numerical score/rating for a descriptive item (Wakeman et al.: Column 1, Lines 58-68; Column 2, Lines 1-5).

Regarding Claims 3, 9-10, 13-14 and 17 Michlowitz et al. does not expressly teach that the responses further comprising an indication of critical items from among descriptive items as claimed.

Case et al. teach a system and method for facilitating comparative evaluation of a plurality of potential suppliers wherein the responses further comprising an indication of critical items (percentage importance, important at all) from among descriptive items (Column 3, Lines 24-65; Column 5, Lines 1-25; Table 1) in an analogous art of supplier evaluation/selection for the purpose of determining the importance of each descriptive item and descriptive item category for relative to a plurality of potential suppliers a reviewer's (customer, buyer, evaluator's, etc.; Column 3, Lines 63-68) decision criteria.

It would have been obvious to one skilled in the art at the time of the invention that the system and method for facilitating comparative evaluation of a plurality of potential suppliers as taught by Michlowitz et al. would have benefited from including an indication of critical items in view of the teachings of Case et al.; the resultant system/method enabling businesses to determine the importance of each descriptive

item and descriptive item category for relative to a plurality of potential suppliers a reviewer's decision criteria (Case et al.: Column 3, Lines 63-68).

Regarding Claims 5-6 Michlowitz et al. teaches a system and method for facilitating comparative evaluation of a plurality of potential suppliers further comprising generating at least one report based on the weighted scores as discussed above.

Case et al. teaches a system and method for facilitating comparative evaluation of a plurality of potential suppliers further comprising generating at least one report based on the weighted scores and the indication of critical items (Column 5, Lines 56-68; Column 14; Column 15, Lines 60-68; Column 16, Line 1-15; Figures 5, 7, 8).

Neither Wichlowitz et al. nor Case et al. expressly teach that the responses include a confidence factor as claimed.

Wakeman et al. teach assigning a confidence factor to each of a plurality of descriptive items relative to a plurality of potential suppliers and further teaches producing an average confidence factor for at least some of the plurality of suppliers (Column 4, Lines 36-43; Column 6, Lines 61-68; Column 7, Lines 1-17; Table 1) and generating at least one report based at least in part on the weighted scores, and the average confidence factors in an analogous art of facilitating evaluation of a plurality of

suppliers purpose of estimating the strength and/or a range of the item's score/rating (Column 1, Lines 58-68; Column 2, Lines 1-5).

It would have been obvious to one skilled in the art at the time of the invention that the system and method for facilitating comparative evaluation of a plurality of potential suppliers as taught by the combination of Wichlowitz et al. and Case et al. would have benefited from assigning a confidence factor to a plurality of descriptive items, generating an average confidence factor as well as creating a report based on the weighted scores and confidence factors in view of the teachings of Wakeman et al.; the resultant system/method enabling businesses (users) to estimate a range of a numerical score/rating for a descriptive item (Wakeman et al.: Column 1, Lines 58-68; Column 2, Lines 1-5).

Regarding Claims 19-20 Wichlowitz et al. teach a system and method for facilitating comparative evaluation of a plurality of potential suppliers further comprising a network to collect responses (Paragraph 0026; Figure 1).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Aycock et al., U.S. Patent No. 5,765,138, teach a system and method of facilitating comparative evaluation of a plurality of potential suppliers comprising distributing and collecting evaluations/responses from a plurality of evaluators/reviewers.

- Spencer, U.S. Patent No. 6,356,909, teach a system and method of facilitating comparative evaluation of a plurality of potential suppliers comprising supplier scorecards and weighting and scoring supplier RFPs.

- Kansal, U.S. Patent No. 6,647,374, teach a system and method of facilitating comparative evaluation of a plurality of potential suppliers comprising rankings/scoring supplier RFP responses by a evaluator, supplier scorecards (matrix), and applying weights to evaluation criteria.

- Shaprio et al., U.S. Patent No. 6,915,269, teach a system and method for decision making by a plurality of evaluators.

- Lee, U.S. Patent No. 7,284,204, teach a system and method of comparative evaluation of a plurality of potential suppliers (strategic sourcing) comprising scoring, rating and ranking, by a scorer/reviewer, of supplier responses, weighting descriptive items relative to the potential suppliers and selecting a supplier.

- Benjamin, U.S. Patent No. 7,356,484, teach a system and method for comparatively evaluating a plurality of suppliers comprising a network, weighting

descriptive items relative to suppliers, categories and supplier scorecards (supplier rating matrix).

- Vashistha et al., U.S. Patent Publication No. 2001/0051913, teach a system and method of facilitating comparative evaluation of a plurality of potential suppliers comprising creating a scorecard (vendor selection matrix) comprising a plurality of descriptive items and categories wherein the items have weights and are assigned a raw numerical score, scoring and ranking supplier RFP responses and generating at least one report.

- Hawkins, U.S. Patent Publication N0. 2002/0107713, teaches a system and method for distributing, collecting and consolidating evaluations from a plurality of evaluators.

- Bye, U.S. Patent Publication No. 2002/0178049, teach a system and method for team-based comparative evaluations of a plurality of potential suppliers.

- Cullen et al., U.S. Patent No. 2003/0200168, teach a system and method of facilitating comparative evaluation of a plurality of potential suppliers.

- Berens, A Decision Matrix Approach to Supplier Selection (1971-72) teaches method of facilitating a comparative evaluation of a plurality of potential suppliers comprising a supplier scorecard (decision matrix) and scoring by a evaluator.

- Avery, Team Approach to buying improves process efficiency (1999), teaches a method of facilitating a comparative evaluation of a plurality of potential suppliers utilizing a plurality of evaluators.

- Hunt et al., Software Acquisition & Supplier Management (2003), teaches a method of facilitating a comparative evaluation of a plurality of potential suppliers comprising a plurality of evaluators, supplier scorecards, and scoring and weighting a plurality of descriptive items relative to the potential suppliers.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to SCOTT L. JARRETT whose telephone number is (571)272-7033. The examiner can normally be reached on Monday-Friday, 8:00AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Van Doren Beth can be reached on (571) 272-6737. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Scott L Jarrett/
Primary Examiner, Art Unit 3623